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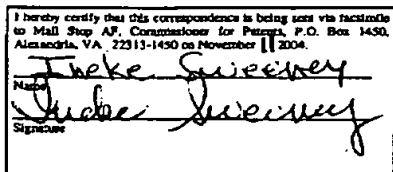
- 1) Reply Brief
- 2) Transmittal Sheet

Number of Pages Including this Page:

- 3)
- 4)

Inventor(s): Hamilton, et al.
S.N.: 10/003,900
Filed: October 25, 2001
Conf. No.: 7854
Case: 8762

Comments:



P&G Case 8762

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :
PETER W. HAMILTON, ET AL. : Confirmation No. 7654
Serial No. 10/003,900 : Group Art Unit 1772
Filed October 25, 2001 : Examiner C. A. Simone

For STORAGE WRAP MATERIAL

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Dear Sir:


Enclosed, pursuant to 37 CFR 1.193(b)(1), is the Reply Brief for the above application.

We do not believe a fee is due. If, however, a fee is due, the Director is authorized to charge any fee which may be required to Deposit Account No. 16-2480.

Respectfully submitted,

PETER W. HAMILTON, ET AL.

By


Peter D. Meyer
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November 11, 2004

Customer No. 27752

Appl. No. 10/003,900
Atty. Docket No. 8762
Reply Brief to Examiner's Answer of October 29, 2004
Customer No. 27752

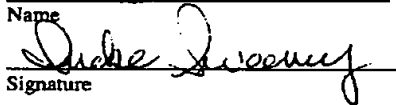
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	10/003,900
Applicant(s)	:	Peter W. Hamilton, et al.
Filed	:	October 25, 2001
Title	:	Storage Wrap Material
TC/A.U.	:	1772
Examiner	:	C. A. Simone
Conf. No.	:	7654
Docket No.	:	8762
Customer No.	:	27752

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REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

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Dear Sir:

INTRODUCTORY REMARKS

This is in response to the Examiner's Answer, mailed October 29, 2004.

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EXAMINER'S ANSWER

The Examiner has acknowledged the correctness of: Section 1 through Section 8 of Appellant's Appeal Brief. Sections 9, Prior Art of Record; and Section 10, Grounds of Rejection, are likewise stated correctly.

This Reply Brief is being filed in view of Section 11, Response to Argument, in the Examiner's Answer.

THE EXAMINER'S POSITION

The Examiner's Answer, page 6, acknowledges Appellant's position that the *McGuire, et al.* reference "fails to teach the adhesive coating having the specific range of about 0.00001 (0.00025 mm) to about 0.0002 inches (0.0051 mm) in thickness." Additionally, the Examiner is correct in that the "McGuire et al. [reference] does, however, teach the thickness of the adhesive coating to preferably range from [sic] *may be about* 0.0005 inch (0.013 mm) to about 0.002 inch (0.051 mm) thick." (Emphasis in original) The Examiner concludes that, "It is not inventive to discover the optimum or workable ranges by routine experimentation."

Additionally, the Examiner has indicated that the Declaration filed by Appellant on November 4, 2003 is merely drawn to Appellant's opinion of the prior art cited by the Examiner. "There is no showing of unexpected results. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range."

APPELLANT'S REPLY

Appellant respectfully submits that to establish a *prima facie* obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, **there must be some suggestion or motivation either in the references themselves or the knowledge generally available to one of ordinary skill in the art to modify the references or to combine reference teachings.** (Emphasis added) Second, there must be a reasonable expectation of success of obtaining the claimed invention based upon references relied upon by the Examiner. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed.Cir. 1991).

Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. It is hard to understand how "the thickness of the adhesive coating would be readily determined through routine experimentation by one having ordinary skill in the art" when the lowest

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value disclosed in the cited reference is 2-1/2 times greater than the upper value of Appellant's claimed range. Further, the midpoint of the range disclosed in the cited reference is approximately 20 times the value of the midpoint of Appellant's claimed range. There is no suggestion or motivation provided in the cited reference to provide Appellant's claimed adhesive thickness. Neither, has the Examiner provided any reasonable expectation of success, nor has the Examiner established that the cited prior art reference teaches or suggest all the claim limitations of the instant Application.

Further, Appellant's declarant stated in the Declaration filed November 4, 2003, that, "The instant application has found that storage wrap materials having adhesive layers thinner than those specified in McGuire can be produced by applying a thin layer of adhesive (0.00001 inch to 0.0002 inch) to a film substrate having a thickness ranging from 0.0001 inch to 0.001 inch. Such thin adhesive layers (0.00001 inch to 0.0002 inch) as claimed in the instant Application are desirable because they provide significant cost savings and processing benefits due to the need for less adhesive." Inasmuch as any Declaration will be drawn to opinion, including opinion of prior art cited by the Examiner, it is hard to understand how the Examiner can determine that "the examples in the Declaration are of no probative value . . . since they do not involve a comparison of Applicant's invention with the closest applied prior art." Such a comparison is unnecessary unless there is some suggestion or motivation in the references themselves or the knowledge generally available to one of ordinary skill in the art to modify the references or to combine reference teachings. *See id.* Indeed, Appellant's Declarant indicates that the cited reference provides no suggestion of a film substrate having an adhesive layer ranging in thickness from 0.00001 inch to 0.0002 inch.

Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. This is because the test for obviousness requires a "suggestion or motivation in the prior art and an expectation of success to be established" and not "something [that] would be readily determined through routine experimentation" when no such suggestion is provided in the reference.

Accordingly, absent any suggestion or motivation by the cited prior art, the *McGuire, et al.* reference cannot render obvious Appellant's claimed invention. *See* M.P.E.P. §2143.03; *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed.Cir. 1988).

Further, the remarks contained within this Reply Brief are an addition to the remarks contained within Appellant's Appeal Brief and Amendments contained in the present Application, which are incorporated herein by reference.

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In light of the foregoing, Appellant respectfully requests the Board to reverse the rejection by the Examiner in this Application, as discussed above.

Respectfully submitted,

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